

REMARKS

In the June 23, 2006 Office Action, the Examiner noted that claims 1-46 were pending in the application; rejected claims 1-46 under 35 USC § 101 and rejected claims 1-3, 11, 19-22, 25-33 and 39 under 35 USC § 102(a). Claims 47 and 48 have been added and thus, claims 1-48 remain in the case. The Examiner rejections are traversed below.

Rejections under 35 USC § 101

In item 2 on pages 2-6 of the June 23, 2006 Office Action, claims 1-46 were rejected under 35 USC § 101 as "directed to non-statutory subject matter." In making this rejection, it was asserted that claims 1-46 "define a non-statutory process" (Office Action, page 2, line 7). This is a mischaracterization of claims 21-30 which are directed to "[a] database system" (e.g., claim 21, line 1) and claims 31-46 which previously recited "[a]t least one computer program stored on a computer-readable medium". Each of the different types of claims will be discussed separately below, because the analysis of whether they recite patentable subject matter is different for each type.

In the last paragraph on page 2 of the Office Action, the Examiner stated "that claims directed to a computer implemented method stored on a computer-readable medium with executable instructions to perform searching of a database for audio files, would be considered to be statutory subject matter." Based on this comment, the preambles of claims 31 and 33 have been amended to recite a "computer implemented method stored on a computer-readable medium with executable instructions to perform searching for a match in a database of a plurality of records, where the records in the database correspond to recordings of at least audio" (claims 31 and 33, lines 1-4) and claims 32 and 34-46 which depend therefrom have been amended to refer to a "computer implemented method" (e.g., claim 32, line 1). Therefore, withdrawal of the rejection of claims 31-46 under 35 USC § 101 is respectfully requested. Since claims 35-38 and 40-46 were not rejected as anticipated by Footnote, an indication of the allowability of these claims is respectfully requested.

As noted above, claims 21-30 are directed to a database system. Claim 21 recites "a storage unit ... and a processing unit" (claim 21, lines 2-4). The specification makes numerous references to a "user's computer" (e.g., page 3, line 3). Hundreds of thousands of patents have issued with claims directed to a computer or its component parts, including a processor and a storage unit as recited in claim 21. The Office Action failed to provide any legal support for ignoring such hardware components and considering a "database system" to be "a non-

statutory process ... [that] merely manipulates an abstract idea" (Office Action, page 2, lines 7-8). The other independent database system claims, claims 22 and 25 also recite a storage unit and a processing unit and claim 25 adds a communication unit. Therefore, withdrawal of the rejection of claims 21-30 under 35 USC § 101 or an explanation of why claims directed to hardware components are non-statutory, is respectfully requested.

The independent method claims are claims 1, 3, 14 and 19. Item 2 of the Office Action did not address these claims individually. As a result, it is unclear what standard is being applied for transformative activity or "post or pre computer process activity" (Office Action, page 2, line 13). While the examples on pages 3-6 of the Office Action are helpful, they do not establish the standard that is being applied.

It is submitted that the first operation recited in claims 1, 3 and 19 and the second operation recited in claim 14, i.e., "generating sample values" (e.g., claim 1, lines 3), constitutes a physical transformation of the signals that *Gelnovatch* and *Schrader* and the cases cited therein found to be statutory subject matter. In addition, it is submitted that claims 14 and 19 recite significant post-solution activity.

Claim 14 recites "indicating as a possible match any of the files represented in the database for which the matching percentage is greater than a predetermined percentage" (claim 14, last 2 lines). This activity clearly requires that information be transmitted and involves more than merely outputting a number, because what is indicated is "a possible match".

On the other hand, claim 19 recites "generating a query based on the sample values ... and sending the query from the user equipment to a server ... to search for at least one matching record" (claim 19, last 3 lines). It is submitted that neither "generating" nor "sending" constitute "merely manipulat[ing] an abstract idea (mathematical algorithm)" as asserted in the Office Action. As disclosed in the specification and known to one of ordinary skill in the art, a "query" is typically electrical signals representing a string of text that may also be encoded in various ways. The transmission of such a query constitutes transfer of physical signals and neither of these operations relate to a mathematical algorithm.

For the above reasons, it is submitted that claims 14 and 19 recite significant post-solution activity and therefore are directed to patentable subject matter for this additional reason.

In case "generating sample values" as recited in all of the independent method claims is not considered to be transformative, claims 47 and 48 have been added depending from claims

1 and 3, respectively, reciting operations that are performed after determining at least one matching record". It is submitted that the operations recited in both claims 47 and 48 constitute significant post-solution activity and therefore, claims 47 and 48 are directed to patentable subject matter, even if claims 1 and 3 are not.

If the Examiner is not persuaded by the arguments above to withdraw all of the rejections under 35 USC § 101, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Interview prior to issuance of another Office Action, to discuss what further amendments are necessary to overcome this rejection.

Rejections under 35 USC § 102(a)

In item 4 on pages 6-12 of the June 23, 2006 Office Action, claims 1-3, 11, 19-22, 25-33 and 39 were rejected under 35 USC § 102(a) as anticipated by an article by Foote (Reference AK in the Information Disclosure Statement filed August 6, 2004) using exactly the same words as in the October 6, 2005 Office Action. The Response to Arguments in item 5 on page 13 of the June 23, 2006 Office Action did not address the arguments in the April 6, 2006 Response, instead asserting that the "arguments ... are moot in view of the new ground(s) of rejection." However, there were no new grounds of rejection under 35 USC § 102(a); therefore, the arguments in the April 6, 2006 Response are repeated below. The Examiner is respectfully requested to respond to these arguments regardless of what other rejections are or are not made in the next Office Action.

In the § 102(a) rejection, the only indication of what was relevant in Foote was "section 3, tree based template generation" (e.g., Office Action, page 3, line 2) and with respect to the limitations recited in claim 2, "section 4" (Office Action, page 3, line 11). One of the many differences between the invention and Foote was discussed in the Amendment filed by Certificate of Mail on May 4, 2005 and received by the Patent and Trademark Office on May 9, 2005. As stated therein, the last three lines of claims 1 and 31 recite "determining at least one matching record in the database for the at least one selected file based on the sample values and **an indication of an amount of data in the at least one selected file**" (emphasis added). No mention has been found in Foote regarding the length or amount of data in each of the recordings being matched.

Section 3 of Foote mentions "an appropriate distance measure to compare the templates" (first paragraph of section 3.1, lines 2-3) and uses the term "distance" **between** items, in this case templates, as a measure of how different the items are. This is unrelated to

the size, length or amount of data of the templates themselves or the recordings from which the templates were obtained.

Section 3 of Footnote also mentions pruning a tree-structured quantizer "to different sizes depending on the amount of data" (paragraph preceding section 3.1, lines 1-2). Once again, the "sizes" and "amount of data" do not refer to individual files or recordings as recited in the claims, but rather to the total number of samples, as indicated by the next sentence, i.e., "the tree size directly determines the size of the histogram template." The "histogram template" is a representation of a sample, not "at least one selected file" as recited in claims 1 and 31.

For at least the above reasons, it is submitted that claims 1 and 31, as well as claims 2 and 32 which depend therefrom, patentably distinguish over Footnote. Nothing has been found in the experiments described in section 4 that relates to indicating an amount of data or "calculating approximate playback times for the files represented by the records in the database and for the at least one selected file" (claim 2, lines 3-4) as asserted in the rejection of claim 2.

Claims 3 and 33 recite "calculating an approximate length of each track of each recording represented in the database and of the selected recording" (e.g., claim 3, lines 5-6) and "determining at least one matching record in the database for the selected recording based on the sample values and the number and length of tracks of the recordings represented in the database and the selected recording" (claims 3 and 33, last 3 lines). No mention of tracks has been found in Footnote, let alone using the number of them in matching records or calculating the length of a track. Therefore, it is submitted that claims 3 and 33, as well as claims 11 and 39 which depend therefrom, patentably distinguish over Footnote for at least these reasons.

Claim 21 recites determining "at least one matching record in the database for the selected recording based on an indication of playback time" (claim 21, lines 5-6). As discussed above with respect to the size, length or amount of data of the selected recording, no suggestion has been found in Footnote of how long it takes to play back a recording or using this playback time in determining whether there is a match. Therefore, it is submitted that claim 21 patentably distinguishes over Footnote for at least this reason.

Claim 22 recites storing "information indicating length and number of identified segments of the recordings" (claim 22, lines 3-4) and "approximate length information and a number of identified segments in the selected recording" (claim 22, last 2 lines). No mention has been found in Footnote of storing such information or using such information to "determine at least one matching record" (claim 22, line 7). Therefore, it is submitted that claim 22 patentably distinguishes over Footnote for at least these reasons.

Claim 25 recites a "number of segments and the length information for the selected recording" (claim 25, line 6) in "a query to search for a match between a selected recording and the records in the database" (claim 25, lines 4-5). No mention of queries containing such information has been found in Footnote. Therefore, it is submitted that claim 25 and claims 26-30 which depend therefrom patentably distinguish over Footnote for at least this reason.

Unlike the claims discussed above, claim 19 does not recite anything about the size, length, or amount of data of files or recordings being compared. Instead, claim 19 recites details of how queries are sent, specifically "sending the query from the user equipment to a server at a second location where the database is stored, to search for at least one matching record" (claim 19, last 2 lines). No mention of servers or user equipment has been found in section 3 or anywhere else in Footnote. Thus, at a minimum, Footnote is a non-enabling reference. Furthermore, it is submitted that there is nothing in Footnote that would make it obvious to one of ordinary skill in the art to implement the matching techniques taught by Footnote in a client-server environment using queries as recited in claim 19. For the above reasons, it is submitted that claim 19 and claim 20 which depends therefrom patentably distinguish over Footnote for at least this reason.

Request for Examiner Interview

The lack of explanation of what in Footnote is believed to anticipate the limitations recited in each of the rejected claims made it impossible to fully respond to the Office Action. If the rejection is not withdrawn as a result of this Response, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview prior to issuing another Office Action, to expedite the process of explaining why the Examiner believes Footnote is relevant to any of the claims and providing the undersigned with an opportunity to respond to that explanation.

Regardless of whether an Examiner Interview is held, it is submitted that the next Office Action should not be final, due to the failure to point out where Footnote discloses each feature of the rejected claims, as required by 37 C.F.R. § 1.104(c)(2).

Summary

It is submitted that Footnote does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-46 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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